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5 SANDISK CORPORATION
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8 **IN THE UNITED STATES DISTRICT COURT**
9 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**
10

11 SANDISK CORPORATION,

12 Plaintiff,

13 vs.

14 MICRON TECHNOLOGY INC.,

15 Defendant.

16 IN RE: SUBPOENA ISSUED IN:

17 SANDISK CORPORATION,

18 Plaintiff and Counterclaim Defendant,

19 vs.

20 ROUND ROCK RESEARCH LLC,

21 Defendant and Counterclaim Plaintiff.
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Misc. Case No. 13-mc-80165 RS JSC
[Related to
Case No. 3:11-cv-05243-RS]

**SANDISK'S REPLY IN SUPPORT
OF ITS MOTION TO COMPEL
PRODUCTION OF SUBPOENAED
DOCUMENTS FROM MICRON
TECHNOLOGY INC.**

24 **REDACTED VERSION**
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1 Micron transferred its ships and cannons to Round Rock in order for Round Rock to attack
 2 SanDisk and others. To assist Round Rock in its privateering efforts, [REDACTED]
 3 [REDACTED] In exchange for its patronage,
 4 [REDACTED] Micron now feigns the part of “nonparty” to
 5 prevent SanDisk from receiving the fundamental discovery it needs to defend itself. But given its
 6 significant past [REDACTED] Micron should not now be heard to
 7 complain about an unspecified and unsupported burden. Instead, that Micron actually developed,
 8 prosecuted, and implemented the patented features makes the documents in its possession so unique
 9 and highly relevant that the unsupported allegations of burden should be disregarded.

10 I. INTRODUCTION

11 A. In Exchange for Litigation Proceeds, Micron Has Agreed to Provide Ongoing 12 Litigation Support.

13 Micron incredulously states that “Round Rock has all the rights to the patents-in-suit” and even
 14 goes so far as to claim that it “has no control over Round Rock.” [Opposition Brief (“Micron Opp.”) at
 15 1:19, 1:21.] However, the Patent Sale and Transfer Agreement, [REDACTED]
 16 [REDACTED] [Dkt. No. 2, Declaration of Janice Ta in Support of
 17 Motion to Compel (“Ta Decl.”) at Ex. E (“Micron/RR Agreement”).] For example, [REDACTED]
 18 [REDACTED]

19 • [REDACTED]
 20 [REDACTED]
 21 [REDACTED]
 22 [REDACTED]
 23 [REDACTED]

24 • [REDACTED]
 25 [REDACTED]
 26 [REDACTED]
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 28 [REDACTED]

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- [REDACTED]

- [REDACTED]

To enhance its chances [REDACTED] Micron is required to provide [REDACTED]

- [REDACTED]

- [REDACTED]

- [REDACTED]

- [REDACTED]

B. Micron Has Provided No Evidence of Burden.

Micron's Opposition Brief is replete with complaints about burden and expenses, but Micron does not provide any declaration from a company representative or make any attempt to quantify the alleged burden or expenses. Rather, Micron presents bare attorney argument (by the same attorneys that represent Round Rock):

We reject the unsupported statements of counsel, made at oral argument before us that the subpoena is overly broad and thus burdensome. Arguments of counsel are not evidence.

Truswal Systems Corp. v. Hydro-Air Eng'g, 813 F.2d 1207, 1211 (Fed. Cir. 1987) (vacating order granting motion to quash filed by nonparty); *see also Acer Inc. v. Technology Properties, Ltd.*, No. C-08-00877 JW, slip op. at 3 (N.D. Cal. Feb. 8, 2012) (criticizing nonparty Seagate for arguing undue burden but "present[ing] no evidence whatever that this is the case. No declarations regarding burden by a knowledgeable Seagate representative accompany the opposition nor do the opposition papers identify just what the burden would be."). So too, Micron's unsupported and unspecified claims of burden should likewise be rejected.

II. MICRON SHOULD PRODUCE DOCUMENTS SHOWING ANALYSES AND KNOWLEDGE OF SANDISK PRODUCTS (DOCUMENT REQUEST NOS. L-1 – L-7).

Absent a declaration or any evidentiary support, Micron complains about the unspecified "burden and expense associated with requiring Micron to plow through those broad categories of documents" [redacted] *SanDisk products*. [Micron Opp. at 9:23–25.] However, the Micron/RR Agreement specifically requires Micron [redacted] [redacted] If Micron is willing (and indeed required) [redacted] [redacted] it should have no problem providing SanDisk with [redacted]

¹ While Micron complains about the breadth of the requests, SanDisk intentionally limited its discovery to Micron's analyses of *SanDisk memory products*, and not the analyses of products from other Micron competitors.

1 Micron’s objections as to confidentiality are similarly unfounded, as Micron has provided no
 2 reason why the Protective Order in this case cannot adequately protect Micron’s sensitive
 3 information. “[I]t is precisely the purpose and function of a protective order to protect confidential
 4 information, i.e., if the information were *not* confidential there would be less or no need for a
 5 protective order.” *Truswal*, 813 F.2d at 1211. The *Truswal* Court refused to “assume that counsel
 6 would breach the duty of an officer of the court by disclosing the [confidential] sales information to
 7 [a] competitor in violation of a protective order.” *Id.* Moreover, it is difficult to understand how the
 8 materials requested in Document Request Nos. L1 – L7 are even highly confidential to Micron in the
 9 first place, as they pertain to Micron’s analyses of *SanDisk products*.

10 Regarding relevance, Micron conflates the standard for relevance with the standard for
 11 proving the merits at trial. It is bedrock law that “[r]elevance under Rule 26(b)(1) is construed more
 12 broadly for discovery than for trial. . . . Where relevance is in doubt, the rule indicates that the court
 13 should be permissive.” *Truswal*, 813 F.2d at 1211–12. The key inquiry at this stage is “whether the
 14 information sought appears reasonably calculated to lead to the discovery of admissible evidence.”
 15 *Truswal*, 813 F.2d at 1212. This is because “[n]o useful purpose would be served in converting
 16 every hearing on a motion to quash a subpoena . . . into a full-fledged trial” *Id.* at 1212.² One
 17 of the elements of laches is that “the plaintiff delayed filing suit for an unreasonable and inexcusable
 18 length of time from the time the plaintiff knew *or reasonably should have known* of its claim
 19 against the defendant.” *A.C. Auckerman Co. v. R.L. Chaides Constr. Co.*, 960 F.2d 1020, 1032 (Fed.
 20 Cir. 1992). Micron has limited its search to documents which specifically “mention the patents-in-
 21 suit” and not documents that analyze SanDisk’s products. [Micron Opp. at 8:6–7] However,
 22 documents reflecting Micron’s analyses of SanDisk’s products are reasonably calculated to lead to
 23 discovery of when Micron knew or reasonably should have known that SanDisk’s products included
 24 certain features alleged to be covered by the Micron patents transferred to Round Rock. Regardless
 25 of whether a document mentions a patent-in-suit by number, the documents requested by SanDisk

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 27 ² Micron ignores this standard and instead cites to cases relating to summary judgment. [See
 28 Micron Opp. at 8.] Indeed, none of the cases cited by Micron involved a motion to quash or for
 protection.

are relevant at least to whether Micron “reasonably should have known of its claim against the Defendant.”

III. MICRON SHOULD PRODUCE ITS TECHNICAL DOCUMENTATION (DOCUMENT REQUEST NOS. G-1, I-1, I-2, J-1, AND K-1).

As discussed in SanDisk’s opening brief, patent marking requires the patentee [Micron] and assignee [Round Rock] to comply with the patent marking statute, 35 U.S.C. § 287. [SanDisk Mot. at 9.] While Micron admits [REDACTED] [Micron Opp. at 5:12–6:4], Micron refuses SanDisk the discovery it needs to show that Micron products actually practice the patents.³ To be clear, and unlike the *Convolve* case relied upon by Micron, SanDisk is not asking Micron to perform a live demonstration at a deposition of how its products work. *See Convolve, Inc. v. Dell, Inc.*, No. C 10-80071 WHA, 2011 WL 1766486, at *2 (N.D. Cal. May 9, 2011). Similarly, SanDisk is not asking for an infringement analysis or for an interrogatory response. Rather, SanDisk has asked Micron for documents describing specific technical features of how Micron products work [such as SyncFlash (Document Request Nos. I-1 and I-2)], how certain specifically identified signals are received (Document Request No. J-1), and similar technical topics.⁴ Micron is in the best position to know which of its products incorporate such technical features, and SanDisk cannot get this discovery from any other party. *See Kilopass Tech. v. Sidense Corp.*, No. C 10-02066 SI, slip op. at 5–6 (N.D. Cal. June 21, 2011) (ordering nonparty to produce technical and financial documents for products employing the accused technology because many of the documents were uniquely in the nonparty’s possession).

Evidence regarding Micron’s incorporation of patented technology into its products is fundamental to establishing that Round Rock is not entitled to any damages prior to the date that Round Rock notified SanDisk of its alleged infringement of the patents-in-suit. If Micron made and sold products that practiced the alleged inventions but did not mark them with the appropriate

³ Micron criticizes SanDisk for seeking “documents that postdate the filing of the patents-in-suit.” [Micron Opp. at 6:11-13.] However, under 35 U.S.C. § 287, the duty to mark begins only after a patent issues, which always “postdate[s] the filing.”

⁴ Unlike the true nonparty in *Convolve*, Micron is not “unpaid.” *Convolve*, 2011 WL 1766486 at *2.

1 patent numbers, Round Rock is not entitled to any damages from SanDisk prior to that date that
 2 Round Rock first provided notice of infringement to SanDisk. *See* 35 U.S.C. § 287(a) (“In the
 3 event of failure to so mark, no damages shall be recovered by the patentee in any action for
 4 infringement, except on proof that the infringer was notified of the infringement and continued to
 5 infringe thereafter, in which event damages may be recovered only for infringement occurring
 6 after such notice”). For example, Round Rock sued SanDisk for alleged infringement of U.S.
 7 Patent No. 6,845,053 (“the ’053 patent”) on May 3, 2012. [Ebertin Reply Decl. at Ex. 1.] Round
 8 Rock alleges that SanDisk infringes claim 24 of the ’053 patent. Claim 24 covers an apparatus,
 9 namely “an electronic system” comprising a processor and a flash memory device. [See Ebertin
 10 Reply Decl. at Ex. 2 (’053 patent at col. 8:3-20).] That system requires the use of a “mode control
 11 bit” which impacts whether the device operates in a high data throughput mode or a low power
 12 mode. [*Id.*] If Micron, as the original owner of the ’053 patent [REDACTED]
 13 [REDACTED]⁵, sold devices incorporating the alleged invention of claim 24 but did not mark such
 14 products with the ’053 patent number, Round Rock is not entitled to recover any damages for
 15 alleged infringement of the ’053 patent prior to May 3, 2012.

16 During the recent deposition of Frankie Roohparvar, a former vice president at Micron who
 17 left in 2012, Mr. Roohparvar testified [REDACTED]
 18 [REDACTED] In particular, Mr. Roohparvar testified that
 19 Micron’s SyncFlash memory products [REDACTED]
 20 [REDACTED] [Ebertin Reply
 21 Decl. at Ex. 3 (Roohparvar Depo. at 130:14-131:1, 132:7-15).] Despite the relevance of this
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25 ⁵ Although Micron “sold” the ’053 patent to Round Rock, [REDACTED]
 26 [REDACTED] Micron’s un-marked sales of products
 27 that practice the alleged invention of the ’053 patent can also operate to cut-off Round Rock’s
 28 damages. *See Amsted Industries Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 185 (Fed. Cir. 1994) (“A license who makes or sells a patented article does so ‘for or under’ the patentee, thereby limiting the patentee’s damage recovery when the patented article is not marked”).

1 product line, Micron has failed to produce its engineering and sales documents regarding the
2 SyncFlash product line.⁶

3 As such, it is clear that Micron has relevant documents regarding its implementation and
4 sales of products which practiced the alleged inventions of the patents-in-suit. To the extent that
5 searching for those documents would require the time of Micron's engineers, Micron could certainly

6 [REDACTED]
7 [REDACTED]
8 [REDACTED] In either event,
9 searching for such documents would not burden Micron in any significant way that Micron did not
10 anticipate when it sold its patents to Round Rock.

11 **IV. REMAINING DOCUMENT REQUESTS**

12 Regarding the remaining topics, SanDisk accepts Micron's representation that it searched for
13 and has no documents, or that Micron will search for and produce documents. Such remaining
14 requests include Document Request No. C-5 [SanDisk Mot. at 9; Micron Opp. at 5]; Document
15 Request No. C-4 [SanDisk Mot. at 11:3–13:7; Micron Opp. at 4:10–5:9]; Document Request
16 Nos. M-1 and M-2 [SanDisk Mot. at 17:15–20:20; Micron Opp. at 3:8–4:9.] SanDisk agrees to
17 withdraw these issues without prejudice based on Micron's representations, but reserves the right to
18 re-raise these issues if discovery reveals that Micron's representations are inaccurate.

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25 ⁶ Documents regarding Micron's SyncFlash product line are also relevant to marking issues
26 concerning U.S. Patent No. 6,570,791 – another former Micron patent being asserted by Round
27 Rock. Mr. Roohparvar testified that [REDACTED]
28 [REDACTED] but without any document production from Micron, Mr. Roohparvar was unable to
recollect relevant details about the product. [Ebertin Reply Decl. at Ex. 4 (Roohparvar Depo. at
142:25-143:13).]

1 **V. CONCLUSION**

2 For the foregoing reasons and because the requested documents are plainly relevant to
3 SanDisk's defenses and claims, SanDisk respectfully requests that the Court order Micron to
4 produce, within ten calendar days of the date of any order resulting from this motion, all documents
5 responsive to SanDisk's Document Request Nos. G-1, I-1, I-2, J-1, K-1, and L-1 – L-7.

6 Dated: August 29, 2013

VINSON & ELKINS LLP

7
8 By: /s/ Chuck P. Ebertin
Chuck P. Ebertin

9 Attorneys for Plaintiff and
10 Counterclaim Defendant
SanDisk Corporation
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PROOF OF SERVICE

I, Chuck Ebertin, certify that:

On August 29, 2013, I caused a copy of **SANDISK’S REPLY IN SUPPORT OF ITS MOTION TO COMPEL PRODUCTION OF SUBPOENAED DOCUMENTS FROM MICRON TECHNOLOGY INC.** to be served on counsel for Micron Technology Inc.

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- by transmitting via electronic mail a true and correct copy of the above-listed document scanned into an electronic file in Adobe “pdf” format.

I declare under penalty of perjury under the laws of the United States of America that the above is true and correct. Executed on August 29, 2013 in Palo Alto, California.

/s/ Chuck P. Ebertin
Chuck P. Ebertin